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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/552,208

12/20/2005

Gerhard Fuhrer

ZAHFRI P782US

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20210 7590 03/17/2009  
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EXAMINER

FORD, JOHN K

ART UNIT

PAPER NUMBER

3744

MAIL DATE

DELIVERY MODE

03/17/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/552,208	<b>Applicant(s)</b> FUHRER ET AL.	
	<b>Examiner</b> John K. Ford	<b>Art Unit</b> 3744	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 10-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 10-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 October 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. ____.                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/06/05</u> .  | 6) <input type="checkbox"/> Other: ____.                          |

Applicant's prior art has been carefully reviewed. DE 69104934T2 (which corresponds to US 5,184,636) appears to be irrelevant to the claimed invention. Please check the numbers carefully and re-submit the proper reference. Applicant may have to go to the search authority to get the proper number as they may have made a typographical error.

As well please provide a complete copy of the German priority document (10315684.4) and a complete copy of published PCT/EP2004/003491 (i.e. applicant's priority applications) in response to this action. The current official file does not have a complete copy of German priority document (10315684.4). The current file also has no copy of published PCT/EP2004/003491 (instead it has a document, WO 2004/106391, assigned to Merck that is clearly not applicant's priority document).

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 10-12, 14-16 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by GB 920,614.

See Figures 1-4 in particular. A transmission case 1 is shown in Figure 1 and a part of that case is designated 24 in Figure 3. As is well known in the art a speed change transmission has an area in which gear wheels rotate (see page 1, col. 1, lines 9-16 and page 2, col. 1, line 50). A tubular heat exchanger (Figure 3) is located in an oil collecting space 7 (applicant's claimed "recess") within the transmission case 24. The heat exchanger can be removed from the oil collecting space 7 (applicant's claimed "recess") within the transmission case 24 by removing screws 28.

The intake of the oil pump is shown at line 34, which line 34 is connected to the suction side of the oil pump.

Claims 10-12, 14 and 16-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Lee (USP 6,217,758).

See Figures 1-3 in particular. A transmission case 14 is shown in Figure 1. A heat exchanger 60 (Figures 2-3) is located in an oil collecting space (applicant's claimed "recess") within the transmission pan. The heat exchanger can be removed from the oil collecting space (applicant's claimed "recess") within the transmission case by removing bolts 33. The intake of the oil pump is shown at line 38, which line 38 is connected to the suction side of the oil pump. The heat exchanger is cooled by engine coolant piped through tubes 62 and 64.

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over GB 920,614 or Lee (USP 6,217,758), explained above, and further in view of Glasson (USP 5,110,045).

Glasson '045 teaches in Figure 1 a transmission oil pump 16 having a suction side connected by conduit 18 to the oil outlet side of a transmission oil cooler 12. A thermostatic bypass valve allows oil to bypass the oil cooler (through line 24 to the suction side of the pump 16) when oil temperatures are low enough that no cooling of the transmission oil is needed.

In view of the teaching of Glasson, it would have been obvious to have configured lines 38 and 34 in GB 920,614 or the lines 38 and 36 of Lee with a thermostatic bypass valve and bypass conduit as taught by Glasson to advantageously avoid overcooling the oil and thereby adversely affecting the efficiency of the transmission by making the oil too viscous.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to John K. Ford whose telephone number is 571-272-4911. The examiner can normally be reached on Mon.-Fri. 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cheryl Tyler can be reached on 571-272-4834. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/John K. Ford/  
Primary Examiner, Art Unit 3744